

DOCKET NO. P04979 (NATI15-04979)
SERIAL NO. 09/938,209
PATENT

REMARKS

Claims 1-26 were pending in this application.

Claims 1-26 have been rejected.

Claims 1, 3, 7, 13, 25, and 26 have been amended as shown above.

Claims 1-26 remain pending in this application.

Reconsideration and full allowance of Claims 1-26 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0106997 to Barber et al. ("*Barber*") in view of U.S. Patent Publication No. 2002/0016189 to Sheynblat et al. ("*Sheynblat*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956

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(*Fed. Cir. 1993*)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir. 1992*); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (*Fed. Cir. 1985*)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (*Fed. Cir. 1993*)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (*MPEP* § 2142).

Claims 1, 13, and 25 have been amended to recite that only a "timer" in a "radio frequency transceiver" is capable of receiving power when the radio frequency transceiver is in one of a "plurality of low-power modes."

Barber recites a method and apparatus for extending the battery life in a radio frequency wireless modem 100. (*Abstract*). The modem 100 is capable of operating in a normal power mode and a low power sleep mode. (*Par. [0064]*). The modem 100 also includes two timers 440, 445. (*Par. [0074]*). The first timer 440 determines the amount of time that the modem 100

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attempts to register with a base station controller. (*Par.* [0074]). Once the first timer 440 expires, the modem 100 enters the low power sleep mode. (*Par.* [0074]). The second timer 445 determines the amount of time that the modem 100 remains in the low power sleep mode. (*Par.* [0074]).

Barber simply recites that the wireless modem may enter a low power sleep mode in response to a timer elapsing. *Barber* also recites that the wireless modem may leave the low power sleep mode in response to another timer elapsing. *Barber* lacks any mention that only timer 440 or only timer 445 receives power when the wireless modem operates in the low power sleep mode.

Sheynblat recites an apparatus for monitoring the battery level in a portable cellular transceiver. (*Abstract*). A comparator compares the battery level to one or more thresholds, and the portable cellular transceiver enters at least one low power mode. (*Abstract; Par.* [0029]). Various low power modes are described in *Sheynblat*, including low power modes that provide enough power for: placing a call of a limited duration, initiating a call, receiving a call, or placing an emergency call. (*Par.* [0029]).

Sheynblat simply recites that the portable cellular transceiver may enter one or more low power modes in response to certain battery levels. *Sheynblat* lacks any mention that only a timer receives power when the portable cellular transceiver operates in one of the low power modes. In fact, *Sheynblat* does not appear to describe any timers in the portable cellular transceiver.

For these reasons, the Office Action does not establish that the proposed *Barber-Sheynblat* combination discloses, teaches, or suggests all elements of Claims 1, 13, and 25 (and

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their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-26.

II. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

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SUMMARY

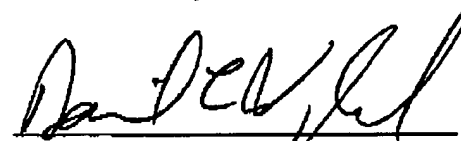
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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Daniel E. Venglarik
Registration No. 39,409

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *dvenglarik@davismunck.com*